

Remarks

Status of Claims:

Claims 1, 5, 7, and 21-34 stand rejected. Claims 1 and 21 are amended. Claim 34 is canceled without prejudice.

Claims 1, 5, 7, and 21-33 remain pending.

The claim amendments made with this response are made without prejudice to applicant filing one or more continuation applications with claims as originally filed or previously presented.

Support for the amendment is found in the specification and drawings as filed. No new matter is added.

§ 103 Rejections:

Claims 1, and 5 are rejected as obvious over Burbank (6471700) in view of Wardle et al. US2002/0120211 (Wardle) in view of Truckai (6,485,436)

These rejections should be withdrawn for the reasons set forth in the prior responses, and all previous arguments are maintained.

Further, it is respectfully urged that Claim 1 as presently amended further distinguishes over the art of record.

Claim 1, as amended, recites among other things:

a tissue piercing element having a conductive tip electrode;

a hollow sleeve adapted to fit over and receive the tissue piercing element therein..

at least two electrodes disposed on the sleeve..... wherein at least a portion of each electrode is positioned distally of a proximal most portion of the tissue receiving opening; and

wherein the tip electrode is disposed distal of and spaced axially from the at least two electrodes disposed on the sleeve when the tissue piercing element is received in the hollow sleeve, and wherein the tip electrode extends through the distal end of the sleeve when the tissue piercing element is received in the hollow sleeve.

It is respectfully urged that even if one combined all the elements from the three different references the Examiner sites, one would still obtain all the limitations of Claim 1 as currently amended.

Claim 21:

Claim 21 is rejected as obvious over Wardle in view of Shadduck (US 6740082). This rejection is improper for at least the following reasons set forth previously.

In addition, Claim 21, as amended, recites among other things:

A biopsy device comprising:

a hollow sleeve comprising..... a lateral opening formed through a portion the unitary sidewall, wherein the lateral opening is configured to receive tissue, wherein the sleeve is configured to axially receive a portion of a biopsy probe instrument, and the sleeve comprising a connector for releasably attaching the sleeve to the biopsy probe instrument;

at least two electrodes disposed on an outer surface of the sleeve, wherein at least a portion of each electrode is disposed proximally of a distal most portion of the lateral opening, and wherein the two electrodes each extend circumferentially about opposed portions of the circumference of the sleeve;
and

a conductive tip electrode slidably received within the hollow sleeve.

It is respectfully urged that even if one combined Wardle and Shadduck as the Examiner suggests, the resulting combination would not provide all the limitations of claim 21, including the recited sleeve with the two electrodes positioned with respect to the lateral opening as recited, and extending circumferentially about opposed portions of the sleeve.

Based on the foregoing, Applicant respectfully requests reconsideration and allowance of the pending claims.

Respectfully submitted,

/Gerry Gressel/
Gerry Gressel

Reg. No. 34,342
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(513) 337-3535

January 28, 2010